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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,312	11/06/2003	Yoshinori Sekine	F-8028	8003
28107	7590	06/15/2006	EXAMINER	
JORDAN AND HAMBURG LLP			DICUS, TAMRA	
122 EAST 42ND STREET			ART UNIT	
SUITE 4000			PAPER NUMBER	
NEW YORK, NY 10168			1774	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/702,312	<b>Applicant(s)</b> SEKINE, YOSHINORI	
	<b>Examiner</b> Tamra L. Dicus	<b>Art Unit</b> 1774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-15-05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The prior rejections are withdrawn due to Applicant's amendments and arguments.

The cancellation of claims 13-16 is acknowledged.

#### *Claim Objections*

Claim 2 is objected to because of the following informalities: it appears a comma is missing between "component" and "a" in line 2 of instant claim 2. Appropriate correction is required.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,933,044 to Ishikawa in view of JP 2001-164163 to Nobuto. Claims 1-12 directed to an invention not patentably distinct from claims 1-9 of commonly assigned patent.

Art Unit: 1774

Although the conflicting claims are not identical, they are not patentably distinct from each other because Ishikawa essentially claims all elements and ordered structure but teaches a metallic luster type ink with pieces of aluminum instead of the claimed invention using a crosslink ink.

Nobuto teaches it is known to incorporate crosslinkable resin ink to aluminum flakes to fix the flakes onto a printing surface with high fastness on plastic films (see Abstract).

Thus, it would have been obvious to one having ordinary skill in the art to have incorporated crosslinker to produce a crosslinking ink as claimed because Nobuto teaches it is known to incorporate crosslinkable resin ink to aluminum flakes to fix the flakes onto a printing surface with high fastness on plastic films (see Abstract, drawings, claims).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,933,044 to Ishikawa.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

Art Unit: 1774

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Ishikawa teaches an insert-molded article comprising a film having transparency (2, FIGS. 3 and 4 and associated text), thermosoftening decorative print layer printed by use of a crosslinking printing ink (3, FIGS. 3 and 4 and associated text) and a binder layer printed with use of a low crosslinking printing or non-crosslinking printing ink (6, FIGS. 3 and 4 and associated text), injected molded resin (4, FIGS. 3 and 4 and associated text). See also 5:1-25. The resins used in the layers are of polyester and the binder layer is partially crosslinked (equivalent to low-crosslinking effect of instant claims 3-4). The ink is also of crosslinked polyester (5:25-30). Claims 1-12 are met.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,682,679 to Marentic et al.

Marentic teaches an insert-molded article comprising a film having transparency (3:50-55, e.g. "clear" such that an image covered by the clear coat is substantially visible through the clear coat), thermosoftening decorative print layer printed by use of a crosslinking printing ink and a binder layer printed with use of a low crosslinking printing or non-crosslinking printing ink (3:5-20, 3:40-45, e.g. one or more intermediate crosslinkable polymer (binder) ink film having a desired image placed one on top of the other and the intermediate layers need not include a catalyst for crosslinking but can during the molding process), and a resin molded (4:30-55, 26, FIG. 7 and associated text, 15:35-16:20). See also FIGS. 5-8 and associated text.

Art Unit: 1774

That the resin is molded by injection is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Claims 1, and 7-12 are met.

Marentic teaches a crosslinked polyester resin and methacrylic resins (6:40-7:30) per instant claims 2 and 5-6.

Marentic also explains that in addition to just using one polyester ink base, a secondary saturated acid added in the crosslinked polyester resin ink effectively reduces the crosslinking and rigidity (7:1-5), thus this explanation is equivalent to a low-crosslinking ink degree that is lower than the other in the print layer as recited in claims 3-4.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

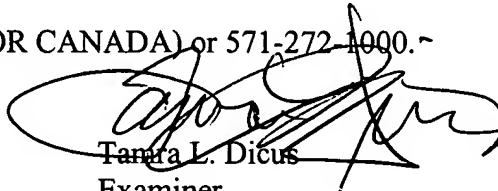
The JP reference is still used to teach the crosslinking composition and also the use of metallic effects.

***Conclusion***

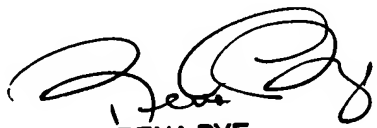
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Tamra L. Dicus  
Examiner  
Art Unit 1774

June 7, 2006

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 6/12/06